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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,143	10/23/2001	Anthony Bove	01-10029	9267

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EXAMINER	
GOFF II, JOHN L	

ART UNIT	PAPER NUMBER
1733	6

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/004,143	BOVE ET AL.	
	Examiner	Art Unit	
	John L. Goff	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 October 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

1. The information disclosure statement filed 10/23/01 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-4 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda (U.S. Patent 4,843,738) in view of Moronaga et al. (U.S. Patent 4,633,598).

Masuda discloses a shoe insole comprising a flexible magnetic core for providing magnetotherapy to a foot. Masuda teaches a method for forming the insole comprising mixing a strongly magnetizable material, e.g. ferrite, with an elastic binder, e.g. NBR rubber, zinc oxide, curing agent, softener, etc., rolling the mixture into a magnetizable sheet, cutting the sheet into an insole section, pressing the sheet along with a nylon mesh at an elevated temperature to form a reinforced magnetizable sheet, perforating the sheet to provide ventilation holes, and magnetizing the sheet to form an insole (Figure 3 and Column 1, lines 6-10 and Column 2, lines 59-68 and Column 3, lines 1-5, 14-30, and 52-68 and Column 4, lines 1-6 and 24-28). Masuda is silent as to providing the magnetizable sheet with a leather upper. It would have been obvious to one of ordinary skill in the art at the time the invention was made to laminate the magnetizable sheet taught by Masuda with a leather upper to provide a soft surface for contacting the foot as this was well known technique in the art for improving the comfort of the insole as shown for example by Moronaga et al. Masuda is further silent as to providing the magnetizable sheet with a cushioning base. It would have been obvious to one of ordinary skill in the art at the time the invention was made to laminate the magnetizable sheet taught by Masuda with a cushioning base to provide a shock absorbing surface as this was well known technique in the art for improving the comfort of the insole as shown for example by Moronaga et al.

Regarding claim 2, it is noted Masuda teaches cutting prior to perforating. However, it would have been well within the purview of one of ordinary skill in the art at the time the invention was made to perforate the magnetizable sheet taught by Masuda as modified by

Moronaga et al. prior to cutting as opposed to after cutting as only the expected results would be achieved.

Regarding claim 7, Masuda is silent as to all possible additives for the magnetizable mixture. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add to the mixture taught by Masuda as modified by Moronaga et al. well known additives for rubber mixtures such as stearic acid and mold-release agent to provide the mixture with a lubricating agent (the stearic acid) and a release agent, i.e. to prevent the mixture of sticking to the roller.

Moronaga et al. disclose an insole for an athletic shoe. Moronaga et al. teach the insole comprises a soft/cushioning leather upper, a flexible rubber core, and a cushioning, i.e. shock-absorbing, base (Figures 1 and 2 and Column 2, lines 61-66 and Column 3, lines 19-21).

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda and Moronaga et al. as applied above in paragraph 4, and further in view of Baermann (U.S. Patent 4,549,532).

Masuda and Moronaga et al. as applied above teach all of the limitations in claim 5 except for a specific teaching of using strontium ferrite as the ferrite powder. However, it is noted Masuda is not limited to any particular type of ferrite powder. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the ferrite powder taught by Masuda as modified by Moronaga et al. strontium ferrite as this was a well known ferrite material used in magnetotherapeutic articles as shown for example by Baermann.

Baermann discloses a magnetic sheet for therapeutic use wherein the sheet comprises particles such as barium or strontium ferrite. Baermann teaches the sheet is magnetized in first

and second polarity configurations consisting of alternating magnetic triangles, concentric circles, etc. to provide optimum therapeutic effects (Figures 1-4 and Column 1, lines 60-68 and Column 2, lines 1-2 and 63-65).

6. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda and Moronaga et al. as applied above in paragraph 4, and further in view of Blume (U.S. Patent 3,127,544).

Masuda and Moronaga et al. as applied above teach all of the limitations in claims 11-14 except for using a magnetizing press to magnetize the sheet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to magnetize the sheet taught by Masuda as modified by Blume using a conventional magnetizing press as was well known in the art as shown for example by Blume as only the expected results would be achieved.

Blume discloses a magnetizing press for magnetizing sheet materials comprising a first roller, i.e. jaw, having magnets with a first polarity configuration, a second roller having magnets with a second polarity configuration, and each roller has bands of dielectric material, e.g. brass, for contacting, i.e. pressing, and pulling the sheet material through the press (Figures 1-3 and Column 1, lines 11-20 and Column 2, lines 25-32 and Column 3, lines 72-75 and Column 4, lines 1-5).

7. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda in view of Moronaga et al., Baermann, and Blume.

Masuda discloses a shoe insole comprising a flexible magnetic core for providing magnetotherapy to a foot. Masuda teaches a method for forming the insole comprising mixing a

strongly magnetizable material, e.g. ferrite, with an elastic binder, e.g. NBR rubber, zinc oxide, curing agent, softener, etc., rolling the mixture into a magnetizable sheet, cutting the sheet into an insole section, pressing the sheet along with a nylon mesh at an elevated temperature to form a reinforced magnetizable sheet, perforating the sheet to provide ventilation holes, and magnetizing the sheet to form an insole (Figure 3 and Column 1, lines 6-10 and Column 2, lines 59-68 and Column 3, lines 1-5, 14-30, and 52-68 and Column 4, lines 1-6 and 24-28). Masuda is silent as to providing the magnetizable sheet with a leather upper. It would have been obvious to one of ordinary skill in the art at the time the invention was made to laminate the magnetizable sheet taught by Masuda with a leather upper to provide a soft surface for contacting the foot as this was well known technique in the art for improving the comfort of the insole as shown for example by Moronaga et al. Masuda is further silent as to providing the magnetizable sheet with a cushioning base. It would have been obvious to one of ordinary skill in the art at the time the invention was made to laminate the magnetizable sheet taught by Masuda with a cushioning base to provide a shock absorbing surface as this was well known technique in the art for improving the comfort of the insole as shown for example by Moronaga et al.

As to perforating the sheet, it is noted Masuda teaches cutting prior to perforating. However, it would have been well within the purview of one of ordinary skill in the art at the time the invention was made to perforate the magnetizable sheet taught by Masuda as modified by Moronaga et al. prior to cutting as opposed to after cutting as only the expected results would be achieved.

As to adding stearic acid and mold release agent to the mixture, Masuda is silent as to all possible additives for the magnetizable mixture. However, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to add to the mixture taught by Masuda as modified by Moronaga et al. well known additives for rubber mixtures such as stearic acid and mold-release agent to provide the mixture with a lubricating agent (the stearic acid) and a release agent, i.e. to prevent the mixture of sticking to the roller.

As to using strontium ferrite as the ferrite powder, it is noted Masuda is not limited to any particular type of ferrite powder. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the ferrite powder taught by Masuda as modified by Moronaga et al. strontium ferrite as this was a well known ferrite material used in magnetotherapeutic articles as shown for example by Baermann.

As to using a magnetizing press to magnetize the sheet, it would have been obvious to one of ordinary skill in the art at the time the invention was made to magnetize the sheet taught by Masuda as modified by Blume using a conventional magnetizing press as was well known in the art as shown for example by Blume as only the expected results would be achieved.

Regarding claim 16, Masuda is silent as to magnetizing the sheet in polarity configurations consisting of alternating magnetic triangles, concentric circles, etc. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to magnetize the sheet taught by Masuda in polarity configurations consisting of alternating magnetic triangles, concentric circles, etc. to provide the sheet with optimum therapeutic effects as taught by Baermann.

Moronaga et al. disclose an insole for an athletic shoe. Moronaga et al. teach the insole comprises a soft/cushioning leather upper, a flexible rubber core, and a cushioning, i.e. shock-absorbing, base (Figures 1 and 2 and Column 2, lines 61-66 and Column 3, lines 19-21).

Baermann discloses a magnetic sheet for therapeutic use wherein the sheet comprises particles such as barium or strontium ferrite. Baermann teaches the sheet is magnetized in first and second polarity configurations consisting of alternating magnetic triangles, concentric circles, etc. to provide optimum therapeutic effects (Figures 1-4 and Column 1, lines 60-68 and Column 2, lines 1-2 and 63-65).

Blume discloses a magnetizing press for magnetizing sheet materials comprising a first roller, i.e. jaw, having magnets with a first polarity configuration, a second roller having magnets with a second polarity configuration, and each roller has bands of dielectric material, e.g. brass, for contacting, i.e. pressing, and pulling the sheet material through the press (Figures 1-3 and Column 1, lines 11-20 and Column 2, lines 25-32 and Column 3, lines 72-75 and Column 4, lines 1-5).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **703-305-7481**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

John L. Goff

Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700